



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,551	10/14/2003	Dale W. Malik	190250-1350	4958
38823 7590 06/05/2008 THOMAS, KAYDEN, HORSTMAYER & RISLEY, LLP/ AT&T Delaware Intellectual Property, Inc. 600 GALLERIA PARKWAY, S.E. SUITE 1500 ATLANTA, GA 30339-5994				
EXAMINER				
HUSSAIN, TAUQIR				
ART UNIT		PAPER NUMBER		
2152				
MAIL DATE		DELIVERY MODE		
06/05/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/685,551

Applicant(s)

MALIK, DALE W.

Examiner

TAUQIR HUSSAIN

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-11, 13-19, 21-27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13-19, 21-27 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/14/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal brief filed on 02/06/2008, PROSECUTION IS HEREBY REOPENED. Rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Response to Amendment

2. This office action is in response to amendment /reconsideration filed on 03/24/2008, the amendment/reconsideration has been considered. Claims 1-4, 6-11, 13-19, 21-27 and 29 are pending for examination, the rejection cited as stated below.

Response to Arguments

3. Applicant's arguments have been fully considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

The listing of references in the specification on page 1 is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "first second third and fourth users" and specifically "indicating to the first user, in response to determining that the second user is engaged in an IM chat session with a fourth user, that the second user is engaged in an IM chat session with the fourth user." must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 16-19, 21-22, 25-27 and 29 are rejected under 35 U.S.C. 101 because, In the light of specification on page 49, applicant has provided that applicant intends the medium to include transmission/propagation media as such claim is drawn to a form of wireless signal and light/electromagnetic waves. Carrier waves or signal does not fall into one of the four categories of invention and therefore, claims 16-19, 21-22, 25-27 and 29 are not statutory. Signal is not a series of steps or acts and thus is not a process. Signal is not a physical article or object and such is not a machine or manufacture. Signal is not a combination of substances and therefore, not a composition of matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. The specification is objected to under 35 U.S.C. 112 first paragraph, as failing to adequately teach how to make or use the invention, i.e., failing to disclose the support in reference to "first second third and fourth users" as described in claimed language of claims 1-4, 6-11, 13-19, 21-27 and 29.

8. Applicant's disclosure is insufficient to allow one of ordinary skill in the art to make or use the invention without undue experimentation because applicant did not adequately disclose the necessary apparatus to perform the claimed method. See in re Gunn, 190 USPQ 402, 406 (CCPA 1976). In fact applicant's disclosure did not even include the term "format server", "first format string", second format string" in the disclosure.

9. Claims 24 and 47 are rejected under 35 U.S.C. 112 first paragraph for reasons set forth in the objection to the specification.

10. It is suggested that applicant could overcome 112 first paragraph rejection by providing a suitably detailed system diagram (with appropriate cross-indexing in the detailed description to reference numerals on said system diagrams.) No new matter should be added.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2146

12. Claims 16-19, 21-22, 25-27 and 29 are rejected under 35 U.S.C 112 second paragraph as being indefinite as the phrase "adapted to" renders the claim indefinite in its entirety.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-4, 6-11, 13-19, 21-27 and 29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Coutts et al. (Pub. No.: US 2003/0120805 A1), hereinafter "Coutts" in view of Morris et al. (Patent No.: SU 6496,851 B1), hereinafter "Morris"

15. As to claims 1, 9, 14-16, 23-25, Coutts discloses the invention substantially, including, receiving an instant messaging (IM) message from a first user to a second user ([0024, lines 2-4], where communication message is inherently an instant message and [0013, lines 12-13], where interactive communication is conducted in real time, Fig.2, Step-204, recipient and Fig.1, Step-102-108, senders and receivers);

prompting the first user for permission to convey the IM message to a third user ([0038, lines 14-19] and [0027, lines 5-13]);

determining whether the second user is currently engaged in an IM chat session with a fourth user (Coutts, Abstract, where determination is made through presence and available status, where available user can be second, third or fourth).

Couts however, is silent on indicating to the first user, that the second user is engaged in an IM chat session with the fourth user. Morris however discloses, indicating to the first user (Morris, Fig.13, Col.12, lines 37-43, where popup window is the indication of response from the second party that proposal has been rejected), that the second user is engaged in an IM chat session with the fourth user (Morris, Fig.13, element-1300, lines 37-43, where message displays as user has declined your chat invitation, where user can be third, fourth etc. and invitation can be due to various reasons e.g. busy, offline or not interested in proposal).

Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to combine the teachings of Coutts with the teachings of Morris in order to provide an instant messaging graphical user interface architecture and a protocol used in a chat room environment which allows users to transmit messages to each other, referred to as "Evil" messages, registering displeasure with any proposal, counterproposal, or acceptance, where an Evil message has a cumulative (and potentially exponential) effect upon a recipient's ability to access the computer system's resources.

16. As to claims 2 and 17, Coutts and Morris discloses the invention substantially as in parent claims 1 and 16, including, receiving an input from the first user (Coutts, [0024, lines 2-4], where communication message is inherently an instant message which can also be an input), the input being indicative of the permission to convey the IM message to the third user (Coutts, Abstract, where forwarding list or buddy list is obviously has the

permission by default to have the messages forwarded to any user in the forwarding list); and

conveying the IM message to the third user in response to receiving the input (Couts, Abstract, where message is forwarded to next person listed on the forwarding list).

17. As to claim 3, 10, 18 and 26, Coutts and Morris discloses the invention substantially as in parent claims 2,9,17 and 25, including, indicating to the first user that the IM message is being conveyed to the third user (Morris, [0041, lines 1-13], where communication message is inherently an instant message and [0013, lines 12-13], where interactive communication is conducted in real time and where response to sender's message itself is a delivery confirmation of a message).

18. As to claim 4, 11, 19 and 27, Coutts and Morris discloses the invention substantially as in parent claim 2,9,16 and 25, including, indicating to the third user that the IM message originated from the first user (Morris, Fig.12, element-1200, where subject of the message indicates the origin of the message which can be a third or any other user).

19. As to claims 6 and 21, Coutts and Morris discloses the invention substantially as in parent claims 1 and 16, including, waiting a predefined time interval prior to requesting prompting the first user for permission (Couts, Abstract, Where forwarding list is a prompting for permission and obviously there is criteria set for forwarding if the user is not available arguably, where predefined time could be null).

20. As to claims 7 and 22, Coutts and Morris discloses the invention substantially as in parent claim 6, including, a second user as unavailable, in the absence of a response from the second user during the predefined time interval, that the second user is unavailable (Morris, Fig.13, Col.7, lines 18-30, where response can indicate in manners described as "online but not available/busy and further modification will be obvious to one of ordinary skilled in the art).

21. As to claim 8, Coutts and Morris discloses the invention substantially as in parent claim 6, including, wherein requesting permission from the first user is responsive to an absence of an input from the second user during the predefined time interval (Morris, Fig.13, Col.7, lines 18-30, where response can indicate in manners described as "online but not available/busy and therefore, message can be forwarded to another device or user and further modification will be obvious to one of ordinary skilled in the art).

22. As to claims 13 and 29, Coutts and Morris discloses the invention substantially as in parent claims 6 and 25, including, further indicating to the first user, in response to determining that the first recipient is engaged in an IM chat session with a fourth user, that an IM chat session is being established between the first user and the third user (Morris, Fig.13, Col.7, lines 18-30, where response can indicate in manners described as "online but not available/busy and therefore, message can be forwarded to another device or user, if proposal gets accepted by a user the response will be generated as discloses in Col.3, lines 64-67 and further modification will be obvious to one of ordinary skilled in the art).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAUQIR HUSSAIN whose telephone number is (571)270-1247. The examiner can normally be reached on 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571 272 3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. H. /
Examiner, Art Unit 2152

/Jeffrey Pwu/
Supervisory Patent Examiner, Art Unit 2146

